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EXAMINER				
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ART UNIT		PAPER NUMBER		
1793				
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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## **DETAILED ACTION**

### ***Response to Amendment***

1. The amendment to the claims submitted on 5/25/2010 will not be entered because it fails to place the claims in better form for appeal. The amendment removes the objected to "hydrogenating" language, but the amended claim language "A process for catalytic or cracking" is still considered to be informal and incorrect.

### ***Response to Arguments***

2. Applicant's arguments filed 5/25/2010 have been fully considered but they are not persuasive.

The argument that Katovic and Rosinski are not combinable is not persuasive. Applicant attributes teachings to both references that are not supported by the actual disclosure of the prior art. Applicant asserts that Katovic requires the use of precipitated silica for the formation of ZSM-12, but Examples 1 and 3 disclosed by Katovic utilize fumed silica and produce ZSM-12 zeolites (p. 969). Katovic does disclose that the use of precipitated silica increases the yield of ZSM-12 compared to colloidal silicas, but does not teach that precipitated silicas are required for the production of ZSM-12 as asserted by applicant. The applicant also asserts that Rosinski requires the use of colloidal silica, but the examples cited by applicant to support this conclusion do not indicate that colloidal silica is required only that colloidal silica may be utilized in the process. The conditions of the exemplary embodiments disclosed by the prior art can not be utilized to infer negative teachings as attempted by applicant. Without further discussion in the prior art the conditions of the exemplary embodiments teach only what

works, and not what will not work. It can not be said that Rosinski teaches away from the use of precipitated silica simply because colloidal silica is utilized in the exemplary embodiments present in the disclosure. Such a conclusion would require an additional teaching regarding the rationale for selecting colloidal and for not selecting precipitated silica. . One of ordinary skill in the art would expect general teachings of the process disclosed by Rosinski that employs colloidal silica, such as possible  $\text{H}_2\text{O}:\text{SiO}_2$  molar ratios, to apply to the process disclosed by Katovic because Katovic discloses that both colloidal and precipitated silicas may be used in the process to produce ZSM-12. The use of different silica precursors is not sufficient to establish the processes of Katovic and Rosinski as exactly opposite for the purposes of producing ZSM-12, and Katovic and Rosinski do not require the use of different silica sources.

The argument that Kresge can not be combined with Katovic or Rosinski is not persuasive. It is agreed that Kresge is directed to the production and use of a ZSM-23 zeolite and not a ZSM-12 zeolite like Katovic and Rosinski. However, Kresge does teach the use of precipitated silicas for the production of zeolite materials. Katovic discloses that precipitated silicas are preferred for the production of ZSM-12 but is silent as to the characteristics of the precipitated silica. One of ordinary skill in the art would then be motivated to look to Kresge for guidance as to what precipitated silicas may be used to produce zeolites. Consulting the teachings of Kresge would be motivated by the disclosure in Katovic that precipitated silicas are preferred for the production of ZSM-12 with no mention of the characteristics of the precipitated silica, and the teaching in Kresge of specific types of precipitated silicas that may be used to form zeolites.

That the zeolite produced by Kresge is not the same as the ZSM-12 produced by Katovic and is utilized in a different manner would not prevent one of ordinary skill in the art from considering the teachings of Kresge with regard to possible raw materials that may be utilized to produce zeolites when considering the lack of guidance provided in Katovic with regard to the surface area of the precipitated silica.

The argument that the process disclosed by Katovic is not the same as the process of the instant application is not persuasive. The rejection is not based on the teachings of Katovic alone, but on the combination of Katovic, Rosinski, Kuhl and Kresge. Any differences between the process applicant considers to be present in the instant application and the prior art process is immaterial because the process disclosed by the combination of the prior art meets all the limitations of the instant claims.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to KEVIN M. JOHNSON whose telephone number is (571)270-3584. The examiner can normally be reached on Monday-Friday 9:00 AM to 5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Curtis Mayes can be reached on 571-272-1234. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Kevin M Johnson/  
Examiner, Art Unit 1793

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